

## **REMARKS / ARGUMENTS**

Claims 28 has been amended in response to the Objections.

All the pending claims have been rejected as obvious under 35 USC 103. The claims have been amended and at least for the reasons set forth below are patentable. Since the independent claims are patentable, the dependent claims are patentable as well without a need for additional reasons. Consequently, certain points in the Office Action do not need to be address for a complete and concise response. However, nothing herein should be interpreted as Applicant's agreement, admission or consent.

Claim 27, as amended, is patentable at least for the following reasons:

Claim 27 has been amended to recite the "an automatically-generated response from computer of the user indicating that the user has opened the e-mail" (supported by paragraphs 71 of the publication of this application A1 20040230495). Kamakura emphasizes to the contrary -- that the recipient must personally respond to the advertising e-mail. Kamakura teaches away from an automatically-generated response by emphasizing human involvement in the response message. See, e.g., col. 10 lns. 18-24 of Kamakura, which state: "Actually, since the recipients are rewarded with those bonus points only when they have replied to the e-mail message, the original sender can expect the reply messages to return at a higher probability. Through this process, the original sender can successfully make access to the recipients and achieve firm communication with them."

Further, claim 27 recites "electronically determining the user's selection; and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection." Obendorf, on the other hand, directs a user to a 3d party website where the user makes a selections. ("A proprietary search engine within the MyPoints site directs consumers to Websites that issue and redeem points" see last sentence in paragraph 4 of Obendorf). Doubtless, Obendorf operates differently from the claim 27.

Also, claim 27 has been amended to recites "advertised product or service" being "displayed in a subject line of the transmitted e-mail." Previously this limitation was

Appl. No.: 10/790,991

included in the dependent claim 78, which has now been canceled. This limitation is not found in the cited art. While the Examiner used Official Notice to support the rejection of this limitation, the Notice has no documentary evidence and, thus, improper because the “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” See MPEP 2144.03 A.

In addition, Obendorf teaches away from the combination with Kamakura since it states that the premise of a loyalty program is “Reward visitors for coming to your online storefront.” See paragraph 3. But, Kamakura rewards for reading e-mails not for “coming to ... online storefront.”

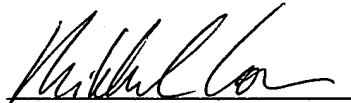
Consequently, claim 27 and all its dependent claims are patentable. New independent claim 80 has the limitations of claim 27 and, therefore, patentable along with its dependent claims.

#### Conclusion

In conclusion, since all the claims are patentable, Applicants respectfully request a timely notice of allowance be issued in this case.

Respectfully submitted,

May 9, 2008



Mikhail Lotvin



Richard M. Nemes

Address: 754 WEST BROADWAY  
WOODMERE, NEW YORK 11598-2948 U.S.A.  
Phone: (516) 374-2959